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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,564	10/31/2003	Tapesh Yadav	037768-0173	1121

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EXAMINER	
TSOY, ELENA	

ART UNIT	PAPER NUMBER
1792	

MAIL DATE	DELIVERY MODE
06/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/698,564	YADAV, TAPESH	
	Examiner	Art Unit	
	Elena Tsoy	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *2,5,7-10,21-23,25,26 and 28-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,11-20,24,27,31 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/18/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2008 has been entered.

Response to Amendment

Amendment filed on April 17, 2008 has been entered. Claims 1-32 are pending in the application. Claims 2, 5, 7-10, 21-23, 25, 26, 28-29, and 30 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation greater than 600 ^{0}C is not supported by the Applicants' specification as originally firled.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for 1500-4000^{0}C, does not reasonably provide enablement for unlimited temperature of greater than 600^{0}C, e.g. 1,000,000 ^{0}C or more. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

4. Claims 1, 4, 6, 11-20, 24, 27, 31 and 32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The high temperature processing conducted at temperatures greater than 1500.degree. C., preferably 2500.degree. C., more preferably greater than 3000.degree. C., and most preferably greater than 4000.degree. C critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicants' specification discloses that metal precursors including claimed metal carboxylate are processed at high temperatures of greater than 1500 ^{0}C to form the product nano-dispersed powder provided by e.g. plasma, combustion, pyrolysis, electrical arcing in an appropriate reactor (See P88-89).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

Claim 16 recites the limitation "the conducting high temperature processing" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 4, 6, 11-15, 17-20, 24, and 31-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bickmore et al (US 5984997) for the reasons of record set forth in paragraph 15 of the Office Action mailed on 7/17/2007 because the scope of the claims are broader than before the amendment.

10. Claims 1, 4, 6, 11-15, 17-20, 24, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konig et al (US 5,356,120) in view of Holzl (US 3,565,676) for the reasons of record set forth in paragraph 17 of the Office Action mailed on 3/9/2007 because the scope of the claims are broader than before the amendment.

11. Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bickmore et al in view of Umeya et al (US 5,489,449) for the reasons of record set forth in paragraph 18 of the Office Action mailed on 3/9/2007.

12. Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konig et al in view of Holzl, further in view of Umeya et al for the reasons of record set forth in paragraph 19 of the Office Action mailed on 3/9/2007.

13. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Konig et al in view of Holzl, further in view of Bickmore et al for the reasons of record set forth in paragraph 19 of the Office Action mailed on 7/17/2007.

Applicants Request for Telephonic Interview with the Examiner

The request for telephonic interview is denied because the examiner is convinced that disposal or clarification for appeal may not be accomplished with only nominal further consideration. The examiner is also convinced that the interview was requested merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search because all arguments submitted together with the Request were directed to non-entered Amendment.

Response to Arguments

Applicants' arguments filed April 17, 2008 have been fully considered but they are not persuasive.

Applicants state that the current Application is entitled to priority data of US 6,228,908 because the present set of claims presents an embodiment in which the temperature range has been eliminated from the previous version of the claims, the claims should be accorded an effective date not later than the filing date of the '893 application, i.e., 05-22-1998. Because of this accorded date, the Bickmore patent is disqualified by § 103(c).

The Examiner respectfully disagrees with this argument. The current Application cannot be entitled to priority data of US 6,933,331 because US 6,933,331 discloses methods of ***using***

nanoscale powders **not** methods of ***making*** nanoscale powders. The US 6,933,331 discloses that methods of *making* nanoscale powders are known and described e.g. in incorporated by reference US 5,984,997 to Bickmore et al. However, *incorporation by reference* is not basis for claiming priority data. Therefore, the current Application is not entitled to priority data of US 6,933,331 and consequently to priority data of US 6,228,908 which is DIV of US 6,933,331.

It is held that when applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the **child CIP**. Any prior art disclosing the invention or an obvious variant thereof having a critical reference date more than 1 year prior to the filing date of the **child** will bar the issuance of a patent under 35 U.S.C. 102(b). See MPEP 2133.01. The current Application is **CIP** of 09/790,036 (now US 6,933,331) where the parent application '036 does not support current methods of ***making*** nanoscale powders. Therefore, the current Application is not entitled to the filing date and priority date of the parent application '036. The current Application is entitled to priority data of the Divisional Application 10/004,387 (US 6,652,967), which is **8/8/2001** (not to filing date of US 6,933,331).

Conclusion

This is RCE of the current application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

MPEP 706.07(b) [R-6] states, "The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114."

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.
Primary Examiner
Art Unit 1792

June 9, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792